



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,609	02/23/2004	Gary L. Cochran	7089-18	8316

30565 7590 06/23/2005

WOODARD, EMHARDT, MORIARTY, MCNETT & HENRY LLP
BANK ONE CENTER/TOWER
111 MONUMENT CIRCLE, SUITE 3700
INDIANAPOLIS, IN 46204-5137

EXAMINER

SHAKERI, HADI

ART UNIT PAPER NUMBER

3723

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/784,609

Applicant(s)

COCHRAN ET AL.

Examiner

Hadi Shakeri

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-18 and 20-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-10, 13-18 and 20-32 is/are rejected.
- 7) ☒ Claim(s) 11 and 12 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 and 11 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 18-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 18-26, "... to hydraulically vertically raise...correspondence with the rotation of said gauge wheel" as recited in section (e) of claim 18 renders the claims indefinite for making the scope unascertainable. Embodiments described for Figs. 1-9, disclose a machine wherein the grinding assembly is raised and lowered by a pivotal movement or action, e.g., page 11, line 4. Applicant in Fig. 10 discloses an embodiment wherein the assembly is raised and lowered vertically relative to the frame, however, no structures and structural relationship between the elements are disclosed for this embodiment and such movement. The relative vertical movement of the assembly does not require the structures and structural relationship as disclosed for the pivotal movements of embodiments of Figs. 1-9. While applicant is entitled to a generic claim for a machine that operates by vertical movement as broadly disclosed on page 12 for embodiment of Fig. 10, the Applicant cannot claim a machine for vertical movement including the structures described for embodiments of Figs. 1-9, e.g., gauge wheel causing said vertical movement, the bell crank, pattern wheel, etc.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3723

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 27-30 (as best understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Thomas et al. (5,957,620).

Thomas et al. discloses all of the limitations of claim 27, i.e., a method of grinding or milling a surface comprising of providing an hydraulic grinding assembly (parent application 08/513,355, US 5,607,255) mounted on a surface mounting portion, e.g., embodiment of Figs. 17a-17c '255, having front and rear ground support elements (344), and raising/lowering the grinding assembly relative to said frame and said front and rear support elements, in correspondence to the rotation of an advancing a gauge wheel.

Regarding claims 28-30, Thomas et al. meets the limitations, i.e., hydraulic drive (12:55); pattern wheel (108) offset from the gauge wheel.

5. Claims 1-5, 7-10, 13- 17, 27, 28 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Dickson (6,402,252).

Dickson discloses all of the limitations of claim 1, i.e., a grinding machine including a surface following frame (12), a hydraulically grinding assembly (74) and a mechanism causing the assembly to be raised and lowered relative to the frame in correspondence with rotation of a gauge wheel (100) in contact with the surface and mechanically linked to the mechanism, e.g., (118, 124, 158).

Art Unit: 3723

Regarding claims 2-5, 7-10, 13-17, Dickson meets the limitations, e.g., grinding assembly pivoted to the frame (Figs. 2 and 3); hydraulic pistons, e.g. (52, 58), pivot arm (48, 62, 55).

Regarding claims 27, 28 and 30, Dickson meets the limitations, e.g., front and rear wheel, e.g., (86) (lacking limitations to define, front or rear) and/or wheels on the support vehicle (14).

Allowable Subject Matter

6. Claims 11 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. It is noted that claims 18-26, 31 and 32 would be allowed, amended, e.g., by deleting "vertically" in section (e), i.e., ...at least one hydraulic piston...to hydraulically raise and lower...

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3723

Response to Arguments

9. Applicant's arguments filed 04/11/05 have been fully considered but they are not persuasive.

The argument regarding Thomas that it does not disclose a grinding assembly that is raised and lowered relative to surface following portion is not persuasive with respect to Figs. 17a-17c '255, which also discloses front and rear wheel forming support 344.

The argument regarding Dickson that it does not disclose mechanical linkage is not persuasive, sine the gauge or displacement wheel (100/106) is mounted to the frame (12) and mechanically linked (at least through 118) to the raising/lowering mechanism

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is (571) 272-4495. The examiner can normally be reached on Monday-Thursday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Hadi Shakeri
Primary Examiner
Art Unit 3723
June 20, 2005